

REMARKS

At the time of the Non-Final Office Action ("Fourth Office Action") dated November 11, 2009, claims 1, 5, 9-12 and 16-18 were pending in this application. Claims 1, 5, 9-12 and 16-18 have been rejected, claims 1, 5 and 12 are amended and claims 2-4, 6-8, 11, 13-15 and 18 were canceled without prejudice and without waiver of subject matter. Claims 19-30 are added. Applicants submit that the present Amendment does not generate any new matter issue.

CLAIMS 1, 5, 9-12 AND 16-18 ARE REJECTED UNDER U.S.C. § 102 FOR ANTICIPATION BASED UPON JUDGE, U.S. PATENT NO. 7,096,498 (HEREINAFTER JUDGE)

On pages 2-6 of the Fourth Office Action, the Examiner asserted that Judge discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single reference.¹ Moreover, the anticipating prior art reference must describe the recited invention with sufficient clarity and detail to establish that the claimed limitations existed in the prior art and that such existence would be recognized by one having ordinary skill in the art.²

¹ In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984).

² See In re Spada, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990); Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).

"Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims. ... The second step in the analyses requires a comparison of the properly construed claim to the prior art."³ During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification,"⁴ and the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach.⁵ Therefore, the Examiner must (i) identify the individual elements of the claims and properly construe these individual elements,⁶ and (ii) identify corresponding elements disclosed in the allegedly anticipating reference and compare these allegedly corresponding elements to the individual elements of the claims.⁷ This burden has not been met.

Claim 1

Independent claim 1, in part, recites "a plurality of cooperative spam control processors, each of said plurality of cooperative spam control processors coupled to a corresponding one of said e-mail clients, wherein said plurality of cooperative spam control processors are configured to detect spam and to notify others of said plurality of cooperative spam control processors of said spam; and,

³ *Medichem, S.A. v. Rolabo, S.L.*, 353 F.3d 928, 933 (Fed. Cir. 2003) (internal citations omitted).

⁴ *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

⁵ *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

⁶ See also, *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, ... will normally control the remainder of the decisional process"); see *Gechter v. Davidson*, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

⁷ *Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

a first group administrator for a common group of e-mail clients, said first group administrator establishes an agreement with a second group administrator for a different group of e-mail clients for the exchange of spam notifications between members of said common group and members of said different group, and at least one member of said common group exchanges said spam notifications with at least one member of said different group based on said agreement.

On pages 2-3 the Fourth Office Action, the Examiner asserted the following:

First, it is noted that this language does not require that the other group administrator actually exist. Rather, if the other group administrator exists, the group administrator must have authority to establish an agreement. As shown in Judge, column 19, lines 13-16, the administrator has the authority to configure the system as the administrator sees fit. Thus, the administrator would also have the authority to establish agreements with other administrators with respect to policies, as the administrator would be able to implement any policy that the administrator desires to implement. (emphasis added).

Applicants have amended claim 1 to require that the second group administrator must exist. Applicants also have amended claim 1 to require the establishment of an agreement between the first group administrator and the second group administrator to control the exchange of spam notifications sent/received by members of the common group and members of the different group. Applicants also have amended claim 1 to require that the exchange of spam notifications be based on the established agreement. Applicants maintain that all limitations of amended claim 1 must be found in Judge in order for the Examiner to establish a prima facie case of anticipation. Accordingly, Applicants respectfully submit that claims 1, 5, 9-10, 12, 16-17 and 19-30 are not anticipated by the applied prior art. Thus, Applicants respectfully submit that a rejection of claims 1, 5, 9-10, 12, 16-17 and 19-30 for anticipation based upon Judge is not viable.

Claims 5-6 and 9-12

Claims 9-10, 12, 16-17 and 19-30 all recite the limitations of:

obeying said notification if said rules indicate that notifications from said peer e-mail recipient are to be obeyed;
ignoring said notification if said rules indicate that notifications from said peer e-mail recipient are to be ignored; and,
overriding said notification where said e-mail message meets criteria established in said policy for overriding a spam notification.

Accordingly, for at least the reasons discussed with respect to amended Claim 1, Claims

9-10, 12, 16-17 and 19-30 are patentable over Judge, and allowance is respectfully requested.

Applicants have made every effort to present claims that distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 50-3829, and please credit any excess fees to such deposit account.

Date: April 9, 2010

Respectfully submitted,

/Steven M. Greenberg/

Steven M. Greenberg

Reg. No.: 44,725

Adam C. Underwood

Reg. No.: 45,169

Customer Number 46322

Tel: (561) 922-3845